

PATENT  
Customer No.: 22,852  
Attorney Docket No. 05725.0878-00

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:	)	
	)	
David W. CANNELL <i>et al.</i>	)	
	)	
Application No.: 09/820,934	)	Group Art Unit: 1615
	)	
Filed: March 30, 2001	)	Examiner: L. Channavajjala
	)	
For: HEAT ACTIVATED DURABLE	)	
CONDITIONING COMPOSITIONS	)	Confirmation No. 4153
COMPRISING C <sub>1</sub> TO C <sub>22</sub>	)	
SUBSTITUTED C <sub>3</sub> -C <sub>5</sub>	)	
MONOSACCHARIDES AND	)	
METHODS FOR USING THE	)	
SAME	)	

**MAIL STOP AF**  
**Commissioner for Patents**  
**P.O. Box 1450**  
**Alexandria, VA 22313-1450**

Sir:

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

In reply to the Final Office Action mailed April 18, 2005, and pursuant to the July 12, 2005 OG Notice regarding the Pre-Appeal Brief Conference Pilot Program, Applicants respectfully request panel review of the outstanding final rejection under 35 U.S.C. § 103(a) identified in the remarks below. No amendments are being filed with this Request. A Notice of Appeal accompanies this Request, which is due July 18, 2005, and is timely filed. A Terminal Disclaimer also accompanies this Request obviating the remaining outstanding rejections.

**REMARKS**

Claims 1-186 are pending in this application. Claims 1-9, 13-19, and 29-59 are under consideration and stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 6,495,498 ("*Niemiec*") in view of U.S. Patent No. 5,688,930 ("*Bertho*"). Final Office Action, page 2.

Applicants respectfully submit this rejection is clearly in error and should be withdrawn because the Office has not met its burden for establishing a *prima facie* case of obviousness. The rejection of record provides no reason, suggestion, or motivation in the prior art to lead one of ordinary skill in the art to combine the teachings of the references in the manner proposed. See *Pro-Mold and Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573 (Fed. Cir. 1996); M.P.E.P. § 2143. A rejection cannot be predicated on the mere identification of individual components of claimed limitations. *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000). Particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *Id.*

The claims recite a composition comprising at least one compound comprising at least two quaternary ammonium groups and at least one sugar chosen from C<sub>3</sub> to C<sub>5</sub> monosaccharides substituted with at least one C<sub>1</sub> to C<sub>22</sub> carbon chain. *Niemiec* teaches cleansing compositions comprising a water soluble silicone agent, a cationic conditioning agent, and at least one detergent. Col. 2, lines 25-32. Possible cationic conditioning agents are listed at col. 5, line 38 to col. 6, line 42. Among those listed are cationic cellulose derivatives, such as Polyquaternium-10. Col. 6, lines 2-8. Other cationic conditioning agents are most preferred, however. Col. 6, lines 39-42. To select

Polyquaternium-10 as the cationic conditioning agent, therefore, one would not only have to disregard those cationic conditioning agents *Niemiec* teaches as most preferred, but would have to select a cationic cellulose derivative from among the other classes of cationic conditioning agents disclosed. Yet no reasons are given as to why the ordinary artisan would have been motivated to select this one particular cationic conditioning agent from among the many possible, including more preferred, options.

The Office emphasizes that “while Polyquaternium-10 is described as one of many cationic conditioning agents, Neimeic (sic) also specifically teaches the compound as one of the few (not a laundry list) film forming agents for hair application.” *Id.* at 4. A careful review of the context for those film forming agents, however, also reveals that the ordinary artisan would arrive at Polyquaternium-10 only by engaging in significant picking and choosing. Specifically, in the embodiment upon which the Office relies, the cleansing composition is formulated with a “benefit agent.” Col. 11, lines 41-44. Benefit agents can be any of approximately 66 active ingredients. See col. 11 at line 56 to col. 12 at line 12. Among this multitude of active ingredients, *Niemiec* lists film formers. Col. 11, lines 56-59. Polyquaternium-10 is included among the 6 nonexclusive examples of film formers (excluding the possible mixtures). Col. 13, lines 1-8.

The ordinary artisan, absent motivation to specifically select Polyquaternium-10, has only a 1 in 66 chance of selecting a film former from among the possible benefit agents, and then at best a 1 in 6 chance of selecting Polyquaternium-10 from the list of film formers. Applicants respectfully submit that the Office has not met its burden for establishing a *prima facie* case of obviousness because neither this reference nor any

arguments by the Office provides a reason, suggestion, or motivation to select the claimed composition.

Similarly, although *Niemiec* teaches the inclusion of a detergent, i.e., a surfactant, in *Niemiec's* cleansing composition, *Niemiec's* list of suitable detergents at column 6 to column 7 is extensive. Among that list is the subcategory of nonionic surfactants. Col. 7, lines 9-19. Long chain alkyl glucosides are included as one of several (non-limited) possible nonionic surfactants, but, as with the selection of Polyquaternium-10, other nonionic surfactants besides the alkyl glucoside are preferred. Col. 7, lines 14-15. Once again, substantial picking and choosing from among numerous possible surfactants would still be required in order to arrive at an alkyl glucoside. However, this is still not enough to lead one to the claimed invention. An alkyl glucoside is a C<sub>6</sub> monosaccharide, which is outside the scope of the claims.

Although the Office acknowledges that *Niemiec* does not teach incorporating the claimed C<sub>3</sub> to C<sub>5</sub> monosaccharides as surfactants, *id.* at 3, it continues to assert that it would have been obvious to add the alkyl pentosides taught by *Bertho* into the hair care composition of *Niemiec* containing Polyquaternium-10 hair conditioner. *Id.* According to the Office, it is enough that "Bertho states that alkyl pentosides are suitable as anionic surfactants for hair applications and can be used with other surfactants, and exemplifies shampoo compositions (col. 19) having conditioning agents. The advantage of combining the alkyl polyglycosides comes from the teaching of Bertho that the compounds are cheap, act as a surfactant with enhanced foaming, emulsifying, and detergent power." *Id.*

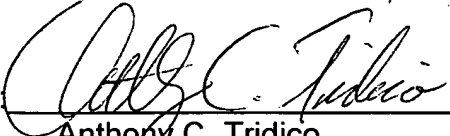
The Office's proposed motivation focuses on the substitution of the alkyl pentoside mixture of *Bertho* for the alkyl glucoside of *Niemiec*. However, the Office's position disregards the fact that there is no motivation to select the alkyl glucoside, and that *Niemiec* lacks more than just a teaching of the alkyl pentoside. Instead, a multi-step selection of the alkyl glucoside plus the independent selection of the Polyquaternium-10 must take place before there can be any basis for substituting the alkyl glucoside with any C<sub>3</sub> to C<sub>5</sub> monosaccharide substituted with at least one C<sub>1</sub> to C<sub>22</sub> carbon chain, let alone the elected alkyl pentoside.

The Office has failed to show why the ordinary artisan at the time the invention was made would have been motivated to select particular components of the composition of *Niemiec*, and then, having made this selection, to substitute the compound of *Bertho* in the composition. Accordingly, Applicants respectfully submit that the Office has not established a *prima facie* case of obviousness. For at least the foregoing reasons, Applicants respectfully submit this rejection is error and should be withdrawn.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

By:   
Anthony C. Tridico  
Reg. No. 45,958

Dated: July 18, 2005